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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,565	12/05/2003	Ronald Earl Uschold	FL0224USNA	8916

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E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
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4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

HU, HENRY S

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,565

Applicant(s)

USCHOLD ET AL.

Examiner

Henry S. Hu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS of 6-17-2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. It is noted that USPTO has received an IDS filed on June 17, 2004. **Claims 1-30** with three different independent claims (**Claims 1, 11 and 22**) are pending now. An action follows.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-10**, drawn to a heat sealable tape comprising a PTFE copolymer, classified in class 526, subclass 242.
 - II. **Claims 11-21**, drawn to a seam formed from two sheet materials comprising the PTFE copolymer on each sheet surface, classified in class 524, subclass 262.
 - III. **Claims 22-30**, drawn to a process for sealing a seam between two sheet materials comprising the PTFE copolymer on each sheet surface, classified in class 264, subclass 328.1+.
3. The inventions are distinct, each from the others because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

Art Unit: 1713

functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case Group I was drawn to a heat sealable tape comprising a PTFE copolymer; while Group II was drawn to a seam formed from two sheet materials comprising the PTFE copolymer on each sheet surface, therefore the scope of the claims, i.e., the metes and boundaries are distinct. Although both inventions may contain the same fundamental copolymer to be useful as adhesive function and the same or similar substrate may be used, **they are actually two different articles in view of the form or shape** as well as in view of the presence or absence of other additive components. It is noted that a seam in Group II is not necessary to be a tape in Group I. The product and its process of making is unique and thereby not interchangeable.

4. **Inventions III and II** are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case Group III is not limited to prepare a seam product specified in Group II, or even to use the copolymer specified in Group II. The only requirement is that the copolymer is functioning as an adhesive and is compatible with the surface of substrate; therefore the process of Group III does not always produce the article useful in Group II.

5. **Inventions I and III** are unrelated. As discussed above, Group I was drawn to a heat sealable tape comprising a PTFE copolymer; while Group III was drawn to a process of making a seam formed from two sheet materials comprising the PTFE copolymer on each sheet surface,

Art Unit: 1713

therefore the scope of the claims, i.e., the metes and boundaries are distinct. Although both inventions may contain the same fundamental copolymer to be useful as adhesive function and the same or similar substrate may be used, **they are actually producing two different articles in view of the form or shape** as well as in view of the presence or absence of other additive components. It is noted that a seam produced in Group III is not necessary to be a tape in Group I. The product and its process of making are unique and thereby not interchangeable.

6. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that one phone call was made to **John S. Hendrickson** (tel: 302 892-7249) on **April 7, 2005** by the examiner and a message was left; the examiner decided a written letter since no response was received from attorney. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1713

Conclusion

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Henry S. Hu whose telephone number is (571) 272-1103. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all regular communications. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

April 15, 2005


DAVID W. WU
SUPERVISORY PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 1700